

REMARKS

Claims 1, 3-6, 8, 11-13, 15, 18-20, 22, 25-27, 29, 32 and 33 are pending. By this Amendment, claims 1, 3, 6 and 8 have been amended. No new matter is involved.

The Office Action rejects claims 1, 3-6, 8, 11-13, 15, 18-20, 22, 25-27, 29, 32 and 33 under 35 USC §103(a) over U.S. published patent application 2002/0009296 to Shaper et al. (hereinafter, "Shaper") in view of U.S. Patent 5,500,639 to Walley et al. (hereinafter, "Walley"). This rejection is respectfully traversed.

Independent claims 1 and 6 have been amended to recite that a unique identification code is transferred by making a physical connection by a lead wire or contact points (between the camera and flash device for claim 1 or between first and second hand-held terminals for claims 6 and 8). Neither Shaper nor Walley discloses or suggests the transfer of the unique identification code through a physical connection in the form of a lead wire or contact points.

The Office Action admits that Shaper fails to disclose (1) that the flash device comprises a collating section for collating a unique identification code that is transmitted from the camera with a unique identification code originally provided in the flash device; and (2) that the unique identification code is transmitted through a physical connection between the camera and the flash device.

The Office Action also admits that Walley fails to disclose "that the unique identification code is transmitted through a physical connection between the camera and the flash device." In fact, Walley discloses absolutely nothing about a camera and a flash device.

Walley is directed solely to "the field of alarm systems" in general and, more particularly, to "methods and apparatus by which satellite units such as sensor units in alarm systems identify themselves."

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071,

1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify a reference or to combine references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the reference as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). A showing of a suggestion, teaching, or motivation to combine the references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The Office Action alleges that it "would be obvious to one of ordinary skill in the art at the time of the invention [to] utilize the automatic identification system of Walley et al. into [sic] the camera system of Shaper et al." The only reason stated to provide the

motivation to do so is "to automate the process and thereby make the operation of the system simpler from a user's point of view."

A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The reasons given by the Examiner are nothing more than broad conclusory statements about the teaching of multiple references, and, as pointed out in Dembiczak, cited above, are not "evidence" of proper motivation to combine these two references.

Accordingly, the Office Action fails to make out a prima facie case of obviousness of the claimed invention.

Furthermore, even if the references are combinable, which they are not, neither applied reference discloses or suggests, with respect to claim 1, that the flash device comprises a collating section for collating a unique identification code that is transmitted from the camera through a physical connection between the camera and the flash device via lead wire or contact points, with a unique identification code originally provided in the flash device; and, with respect to claims 6 and 8, that the second hand-held terminal comprises a collating section for collating a unique identification code that is transmitted from the first hand-held terminal by making a physical connection between the first and second hand-held terminals via lead wire or contact points, with a unique identification code originally provided in the second hand-held terminal. The Office Action's motivation for supplying features totally missing from either reference is based on speculation and/or impermissible hindsight.

Applicant also notes that the aforementioned claim features effectively recite that the unique identification code is automatically transmitted from the camera (or first hand-held device) "by making" the recited physical connection. The specification clearly indicates that

"... necessary identification codes are registered by the photographer's connecting the camera 1 to each of the first and second flash devices 2 and 3 in advance by the lead wire 23 or the contact points 23A and 23B . . ." - see, for example, the specification on page 30, lines 10-13. No such features is disclosed or suggested in Shaper or Walley.

Additionally, the assertion that the "use of connector pins or wires to transmit the identification numbers is equivalent to the transmission of radio waves" and that it "is a matter of design choice to choose one method over another" overlooks the explicit requirements of In re Lee and In re Dembiczak, cited above, which require objective evidence of record to demonstrate obviousness of a claimed invention, rather than what is applied here, which is merely unsupported conclusions.

Moreover, by limiting its disclosure to "wireless remote control for photographic equipment," - see col. 1, paragraph [0001], Shaper teaches away from using wired or direct physical contacts to achieve remote controls for cameras. Shaper is directed to improving cameras in which photographers "require wireless remote control of their cameras" - see col. 1, paragraph [0002], first sentence.

Lastly, Applicant respectfully submits that the explanation of why the previous indication of allowability of claims that recite "the transfer of unique identification code of the flash device being transmitted in advance through the physical connection of the camera and the flash device" was withdrawn, is improper.

The rationale for the withdrawal of the indication of allowability is because "the teachings of Shaper et al. and Walley et al. of transferring identification codes through radio waves are equivalent to transferring those codes through physical connections."

Applicant respectfully submits that just because something may be equivalent to something else does not make the equivalent obvious. Moreover, the type and degree of equivalency is not stated in the Office Action. As pointed out above, the Examiner has to

provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Simply because, in hindsight, something may be an equivalent in some unstated manner to another thing, does not necessarily make the use of the equivalent obvious or provide proper motivation to one of ordinary skill in the art to make the substitution.

Furthermore, as noted above, neither applied reference discloses the positively recited features in the pending claims, including, with respect to claim 1, that the flash device comprises a collating section for collating a unique identification code that is transmitted from the camera by making a physical connection between the camera and the flash device via lead wire or contact points, with a unique identification code originally provided in the flash device; and, with respect to claims 6 and 8, that the second hand-held terminal comprises a collating section for collating a unique identification code that is transmitted from the first hand-held terminal by making a physical connection between the first and second hand-held terminals via lead wire or contact points, with a unique identification code originally provided in the second hand-held terminal.

Dependent claims 3-5, 11-13, 15, 18-20, 22, 25-27, 29, 32 and 33 are patentable over Shaper and Walley at least for the reasons that the claims from which they depend are patentable over Shaper and Walley, and the rejection of claims 1, 3-6, 8, 11-13, 15, 18-20, 22, 25-27, 29, 32 and 33 should be withdrawn.

In view of the foregoing, Applicant respectfully submits that the rejection of claims 1, 3-6, 8, 11-13, 15, 18-20, 22, 25-27, 29, 32 and 33 is improper and should be withdrawn.

Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,



Mario A. Costantino  
Registration No. 33,565

Robert J. Webster  
Registration No. 46,472

MAC:RJW/sxb

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**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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